

**REMARKS**

Reconsideration of this application, in view of the foregoing amendment and the following remarks, is respectfully requested.

Claims 1-52 were originally presented for consideration in this application. Claims 1 and 43 have been canceled. Accordingly, claims 2-42 and 44-52 are currently pending in this application.

The following rejections were set forth in the Office Action:

1. Claims 1, 30, 38, 43 and 44 stand rejected under 35 USC §102(b) as being anticipated by U.S. Patent No. 6,299,258 to Wright et al.;
2. Claims 1, 30, 31 and 36 stand rejected under 35 USC §103 as being unpatentable over U.S. Patent No. 983,855 to Aton in view of U.S. Patent No. 4,200,326 to Wilcox;
3. Claims 2-4, 13, 14, 17-20, 33, 34, 43 and 44 stand rejected under 35 USC §103 as being unpatentable over Aton in view of Wilcox, and further in view of U.S. Patent No. 5,788,263 to VanDenberg;
4. Claims 15, 16, 21, 32, 35 and 38 stand rejected under 35 USC §103 as being unpatentable over U.S. Patent No. 983,855 to Aton in view of Wilcox, and further in view of VanDenberg, and still further in view of Azevedo; and
5. Claim 39 stands rejected under 35 USC §103 as being unpatentable over Aton in view of Wilcox, and further in view of Spindler.

Regarding the anticipation rejections, please note that independent claim 1 has been canceled above, and independent claim 30 has been amended to recite that at least two beams are attached to the axle assembly, with the beams pivoting relative to a

vehicle frame. The Wright reference does not disclose or suggest such a suspension system. Indeed, Wright merely describes a rigid attachment of an axle to a container, so that the container is not "suspended" above the axle at all. Thus, Wright does not anticipate the amended claim 30 (or claims 38, 43 and 44 dependent therefrom).

Various of the claims dependent from claim 30 have been amended above to conform them to the amendment made to claim 30. Some of these amended dependent claims were previously withdrawn as being non-elected in response to the earlier requirement for election of species. However, due to the allowability of independent claim 30, these non-elected dependent claims may now be considered in this application.

Regarding the obviousness rejections, the applicants respectfully traverse these rejections. Each of the rejections uses the Wilcox reference for its alleged teaching of an axle made from a composite material. However, Wilcox merely teaches the use of a hollow steel axle having a hardenable foam injected therein.

Neither the steel material nor the foam material is a composite material. Instead, they are separate materials which remain separate from each other. In contrast, a composite material has multiple constituents which are combined to form a single material. This is how a person skilled in the art understands the term "composite material."

Since Wilcox does not teach or suggest the use of any composite material in his axle assembly, the combination of elements in the recited claims have not been met by the combination of references used to reject the claims, and so a *prima facie* case of obviousness has not been made out. There are additional reasons why a *prima facie* case of obviousness has not been made out for the rejected claims, and these reasons are discussed briefly below.

There is no teaching or suggestion in any of the references to make the combination of references proposed in the claim rejections. It appears that the claims

have been used as a “recipe” to sift through the prior art and select various references which teach bits and pieces of the claimed invention, and then assemble these pieces in an attempt to reach the limitations recited in the claims. This is improper. As stated in MPEP §2142, “The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant’s disclosure.”

The references have been selected to show that certain capabilities recited in the claims exist in the prior art. However, as stated in MPEP §2143.01, “The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.” Here, there is no such suggestion of desirability of the combinations in the prior art.

In the present case, the principal Aton reference is directed to a detachable spindle for an axle. The Wilcox reference is used for its teaching of an axle construction. However, the Wilcox axle is for railway wheels and does not use any composite materials. In addition, there is no motivation or suggestion as to why a person skilled in the art would modify the Aton axle to incorporate the Wilcox axle construction.

The VanDenberg reference is used for its teaching of a suspension system having pivoting beams. However, there is no teaching in VanDenberg of how to solve the significant problem of how such pivoting beams could be attached to an axle assembly using a composite material. Certainly, Wilcox would not use pivoting beams with a railway car axle. Thus, there is no teaching or motivation to combine these references, and no reasonable expectation of success.

The Azevedo reference is used for its teaching of an adhesive coating. However, there is no teaching in any of the references of using such an adhesive coating to bond a sleeve to an axle, to weld beams to sleeves, or to bond spindles to axles as recited in the claims. It is pure conjecture that a person skilled in the art would conceive of doing so based on the teachings of Azevedo. Again, there is no motivation or suggestion

expressed in the art for making the combinations of references used in the claim rejections.

The Spindler reference is used for its teaching of a spindle with a brake mounting. However, the Spindler reference teaches away from the claimed invention, at least in part in that Spindler teaches a friction or inertia weld between the spindle and the brake mounting, and between the spindle and the axle, which would not be amenable to use with composite materials. A person skilled in the art would definitely not be motivated to combine the Spindler reference with a composite axle.

Thus, it may be seen that a *prima facie* case of obviousness has not been made out for any of the rejected claims.

The examiner is respectfully requested to consider in this application the claims which were non-elected in response to the requirement for election of species, but which are dependent from allowable claims.

In view of the foregoing amendment and remarks, all of the claims pending in this application are now seen to be in a condition for allowance. A Notice of Allowance of claims 2-42 and 44-52 is therefore earnestly solicited.

The examiner is hereby requested to telephone the undersigned attorney of record at (972) 516-0030 if such would expedite the prosecution of the application.

Respectfully submitted,

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